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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/322,594	05/28/1999	GLENN PETKOVSEK	USA-P99-005	8241

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/322,594

Applicant(s) *He*

PETKOVSEK, GLENN

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petkovsek (5,697,648).

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Petkovsek discloses in Fig. 1, 2 and 6, a mailing assembly and a method for preparing a mailpiece comprising a backing sheet (11), first and second mailing forms (10a and 10b) removably attached to the backing sheet by an adhesive (Col. 6, lines 21-25) and separable by a tear line (60) wherein the forms includes a first return postcard (18) integrally formed with a designator section (24A) indicative of a special service (Col. 4, lines 29-31) having an area consisting of a machine readable code (24), which aids in tracking the mailpiece being sent, and distinctly colored (Col. 4, lines 40-41) and is contained within the first exterior sides (right of perforated line 29a, and left of perforated line 33a) that defines the postcard; wherein the first mailing form (10a) is removably attached (60) to the second mailing form (10b); wherein the second mailing form (Fig. 6) has a second return postcard (18b) integrally formed with a second designator section which is contained within the second exterior sides of the second return postcard; a first anchor portion (28) extending outside one of the exterior sides (33a) of the first return postcard, wherein the first anchor portion has adhesive (48) on the backside (Fig. 2), is removably attached to the postcard via a tear line (33) a removable label section (30) attached to the first anchor portion (28) via a tear line (32), a third designator section (36) contained within the first anchor portion, and a second anchor portion (27) removably attached to the return postcard by a tear line (29).

However, Petkovsek does not disclose: a first designator section has a color corresponding to a special services for delivery of a mailpiece wherein the color is different for each one of the special services; wherein the designation section has an area for receiving

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instructions regarding delivery of the mailpiece by the special service; a special service which includes one of certified, registered, insured mail, COD and return receipt.

In regards to **Claim 1**, a recitation of the intended use (a color corresponding to one of a plurality of special services for delivery) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, since Petkovsek discloses that “other sections, as well, may include similar color-contrasting portions”, the mailing assembly is capable of having various color changes corresponding to what is desired by the end user.

In regards to **Claims 1 and 7-9**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section since it would only depend on the intended use of the assembly and the desired information to be displayed. *In re Gulack* 217 USPQ 401, (CAFC 1983). Since applicant has not defined in detail what “special service” entails in Claims 1 and 9, the examiner has interpreted “special service” in its broadest sense.

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Furthermore in regards to **Claim 8**, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431.

In regards to **Claims 13-15**, the method for preparing a mailpiece for delivery is inherently taught by Petkovsek.

Furthermore, in regards to **Claim 13**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The bar coded area of Petkovsek is capable of receiving instructions regarding the delivery of the mailpiece by a special service, since it would be obvious to program the bar code to receive or transmit any desirable information depending on the intended use of the bar coded area and the desired information to be retrieved.

2. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walz (5,664,725) in view of Popat et al (6,001,209).

Walz discloses in Fig. 1, 4 and 5, an assembly comprising a first form (84) having a first postcard (70), a first anchor portion (58) removably attached to the postcard via a tear line (24),

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wherein the first anchor has adhesive (16) on the backside of the anchor (seen in Fig. 5), a first backing strip (49) received over the adhesive on the anchor portion's backside, an integrally formed designator section (73) indicative of special services such as restricted delivery which can consist of: certified mail, COD, insured mail, etc..(Col. 4, lines 45-48), an area (66) contained within the postcard printed with machine readable code (75), and a second form (82) removably attached to the first form by a tear line (20).

However, Walz does not disclose: a second form having a second postcard and a second anchor portion; and a first return postcard having no adhesive.

Popat et al discloses in Fig. 10, an assembly comprising a first form (254a) and a second form (254b), having anchor portions (258, 256, 256c) wherein a tear line (252c) is arranged to separate the first form from the second form.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz's assembly to include multiple form assembly connected by a tear line as taught by Popat et al for the purpose of printing multiple areas of a sheet without disposing extra unused paper area and for providing convenience for anyone using an advanced printer.

In regards to **Claim 16**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section since it would only depend on the intended use of the assembly and the desired information to be displayed. *In re Gulack* 217 USPQ 401, (CAFC 1983). Since applicant has not defined in detail

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what “special service” entails in Claim 16, the examiner has interpreted “special service” in its broadest sense.

Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable amount of mailing forms with postcards and anchor portions, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the two substrate return postcard as a single substrate postcard, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Response to Arguments

3. Applicant's arguments filed on November 25, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument that the Petkovsek and Walz references do not disclose a designator section within the exterior sides that define a postcard wherein the designator section is integrally formed with the return postcard, the examiner submits that both

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Petkovsek and Walz discloses a designator section in Fig. 1 as set forth in the above 103 rejections. Further, since applicant has not defined in detail what "special service" entails in Claim 16, the examiner has interpreted "special service" in its broadest sense. Furthermore, Applicant's arguments regarding "the special designation section" do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

In regards to Applicant's argument that the prior art of record does not teach a first and second return post card wherein the "return post cards do not have an adhesive backside", the examiner submits that Walz does indeed teach that the backside of the post card (78) does not have adhesive. The return postcard in the Walz reference is considered is disclosed as having two substrates divided by an adhesive (as seen in Fig. 1, (front) and 5 (back) and 3 (showing adhesive which divides the substrate). Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the two substrate return postcard as a single substrate postcard, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

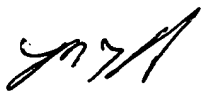
In regards to applicant's argument that the prior art does not teach a first designator section having a color corresponding to one of a plurality of special services for delivery of a mail piece, the examiner submits that Petkovsek does teach that the designator can have a color-contrasting portion, wherein the color chosen depends on the intended use of the end user.

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Petkovsek does not disclose that the use of the color is to assist a machine in reading a code printed in the designator section. Petkovsek states that the color assistance was used for "subsection 26" which operates entirely different than designator section 24A.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, a. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 13, 2002



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